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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,366	12/04/2003	Phillip M. Adams	2456.2.6.4	6962

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/727,366

Applicant(s)

ADAMS, PHILLIP M.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 16-21 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's election without traverse of Claims 1-15 filed on 10/05/2006 is acknowledged. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 16-21 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

The disclosure is objected to because of the following informalities:

Line 4 on page 3 of specification appears to be not finished.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of independent claims does not correspond to the body of the claims. Specifically, the preamble of the independent claim 1 indicates a method for *enforcing* the correction; however, the body of the claim does not include any recitation of said *enforcing* functionality. Same reasoning is applied to the independent claim 10.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobata (US 6,321,348).**

Kobata teaches a method for correcting computer hardware and software defects, comprising:

Claim 1,

providing, by a supplier, a product having an embedded defect causing the product to artificially reject operation with a class of associated products for interacting therewith (C. 2, L. 52-62);

discovering the existence of the embedded defect (C. 2, L. 52-62);

disclosing the existence (C. 2, L. 52-62);

repairing the product by enabling operation of the product with the class (C. 3, L. 59-62).

Claims 4-8. Same reasoning as applied to claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2, 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobata.**

Claim 2. Kobata teaches all the limitations of claim 2, including discovering the existence of the embedded defect over the Internet (C. 3, L. 52-62), except specifically teaching that said disclosing further comprises *publicly* disclosing.

Official notice is taken that it is old and well known that the use of the Internet include accessing information posted on a Web site.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said disclosing further comprises *publicly* disclosing, because it would advantageously allow to provide said information to any interested party substantially instantaneously.

Claim 3. Kobata teaches all the limitations of claim 2, including discovering the existence of the embedded defect over the Internet (C. 3, L. 52-62), except specifically teaching that said disclosing further comprises *privately* disclosing.

Official notice is taken that it is old and well known to encrypt data transmitted over the Internet to provide a secure/private transaction.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said disclosing further comprises *privately* disclosing, because it would advantageously allow to prevent losses of proprietary information.

Claim 9. Kobata teaches all the limitations of claim 9, including offering, by an independent third party, a solution including installing new software (C. 2, L. 52-62; C. 3, L. 40-43, 57-58; Fig. 1), except specifically teaching that said offering further comprises offering a *license* to the solution.

Official notice is taken that it is old and well known to license a software.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said offering further comprises offering a *license* to the solution, because it would advantageously allow save funds and time by not designing own dedicates software.

**Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobata in view of Liability For Product Incompatability and further in view of Moran (US 7,085,936).**

Claim 10. Kobata teaches said method for correcting computer hardware and software defects, comprising:

providing, by a supplier, a product having an embedded defect causing the product to artificially reject operation with a class of associated products for interacting therewith (C. 2, L. 52-62);

discovering the existence of the embedded defect (C. 2, L. 52-62);

disclosing the existence (C. 2, L. 52-62);

repairing the product by enabling operation of the product with the class (C. 3, L. 59-62).

Kobata does not specifically teach providing *motivation* to the supplier; and that said repairing the product is conducted *in response to the motivation*. Also, Kobata does not specifically teach *perceiving a delay in correction of the embedded defect* in response to the disclosure.

Liability For Product Incompatability (Liability) which appears to be published in September 1998, discloses that suppliers who sold products which causes software or hardware incompatability issues face potentially lawsuits from dissatisfied customers (page 2, lines 1-2), which indicates strong reason for suppliers to fix identified problems timely.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include providing *motivation* to the

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supplier; and that said repairing the product is conducted *in response to the motivation*, as suggested in Liability, because it would advantageously allow suppliers to avoid financial losses associated with litigation as well as losing customers.

As per *perceiving a delay in correction of the embedded defect*, it is old and well known fact. For example, Moran discloses that most software vendors, responsible for software vulnerabilities, persistently refuse to fix said vulnerabilities (C. 35, L. 54-56).

Claims 11, 12, 14 and 15. Same reasoning as applied to claim 10.

Claim 13. The fact of infringing software application is old and well known.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB  
10/13/2006



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PRIMARY EXAMINER